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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.                  |
|--|-------------|----------------------|---------------------|-----------------------------------|
| 09/665,349   | 09/18/2000  | Mark A. Harper       | 10003223-1          | 4554                              |
| 22879  | 7590        | 11/20/2003           |                     |                                   |
| HEWLETT PACKARD COMPANY<br>P O BOX 272400; 3404 E. HARMONY ROAD<br>INTELLECTUAL PROPERTY ADMINISTRATION<br>FORT COLLINS, CO 80527-2400 |             |                      |                     | EXAMINER<br>THEIN, MARIA TERESA T |
|  |             |                      |                     | ART UNIT<br>3625                  |
|  |             |                      |                     | PAPER NUMBER                      |

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/665,349             | HARPER ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Marissa Thein          | 3625                |  |

***– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –***

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 05 September 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-23 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-23 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.  
4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicants' "Amendment B" deposited on September 5, 2003 has been considered with the following effect.

Claims 1-23 remain pending and an action on the merits of these claims follows.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claim 15 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. 09/648,664 to Harper et al. in view of U.S. Patent No. 6,333,790 to Kageyama.** Application No. 09/648,664 substantially discloses the claimed invention, however, it does not disclose the receive a reply message including

information describing status of an order for the consumable commodity. Kageyama, on the other hand, teaches the receiving of the reply message which includes information describing the status of an order for the consumable commodity (see at least col. 10, lines 47-50; col. 12, liens 56-64 and Figures 7 and 9). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Harper to include the reply message, as taught by Kageyama, in order to transmit the information on completion of the order (Kageyama col. 2, lines 35-38).

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 4, 6-8, 11-12, 14-15, 17, 19, and 21-23 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,430,711 to Sekizawa in view of U.S. Patent No. 5,517,617 to Sathaye et al.** Regarding claims 1 and 23, Sekizawa discloses a method of programming a non-volatile memory unit (col. 19, lines 44-47; col. 20, lines 5-16) and obtaining consumable supplies in a hard copy output engine comprising:

- determining a geographical area within which the hard copy output engine is to be deployed (see at least col. 3, lines 21-27; col. 4, lines 1-5; col. 8, lines 3-7; col. 23, lines 39-45; col. 25, lines 55-64; col. 27, lines 8-14; col. 36, lines 51-58);

- determining an electronic address for a consumables supplier appropriate to the geographical area (see at least col. 6, lines 51-61; col. 19, lines 6-14; col. 19, lines 15-35);
- proactively initiating communication with the consumables supplier from the hard copy output engine and using the stored electronic address if an amount of a consumable for the hard copy output engine is less than a predetermined threshold (see at least col. 19, lines 15-35; col. 19, lines 22-27; col. 33, lines 31-35; col. 34; col. 34, lines 22-55; col. 46, lines 7-31).

However, Sekizawa does not explicitly disclose the programming and storing the electronic address into the non-volatile memory. Sekizawa disclose the ROM (Read Only Memory) memory storing a BIOS program (see at least col. 19, lines 44-47; col. 20, lines 5-16). Sathaye, on the other hand, teaches the storing and programming the electronic address into the non-volatile memory (see at least col. 1, lines 38-51). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Sekizawa, to include the programming and storing of the electronic address into the non-volatile memory, in order to keep track of addresses of addressable network entities (Sathaye col. 1, lines 52-53).

Regarding claims 4, and 6-7 (which depend on claim1), Sekizawa discloses product descriptors for consumable supplies associated with the hard copy output engine (see at least col. 9, lines 11-44); the hard copy output engine is chosen from the group consisting of: facsimile machines, photocopiers and printers (see at least col. 3, lines 11-13; col. 3, lines 44-46); and a supplier chosen from the group consisting of: an

original equipment manufacturer, a reseller, or a supplier of office supplies including hard copy output engine consumables (see at least col. 6, line 51-63; col. 9, lines 34-40; col. 19, lines 6-14).

Regarding claim 8, Sekizawa discloses a method of obtaining consumable supplies for a hard copy:

- determining that an amount of consumable for the hard copy output engine is less than a threshold amount (see at least col. 9, lines 44-57; col. 10, lines 3-8; col. 15, lines 22-32; col. 28, lines 44-67; col. 34, lines 23-54) ; and
- initiating communication with the vendor using the electronic address (see at least col. 19, lines 15-35).

However, Sekizawa does not explicitly disclose the extracting of an electronic address for a vendor from a non-volatile memory. Sekizawa disclose the ROM (Read Only Memory) memory storing a BIOS program (see at least col. 19, lines 44-47; col. 20, lines 5-16). Sathaye, on the other hand, teaches the extracting of an electronic address for a vendor from a non-volatile memory (see at least col. 1, lines 29-35). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Sekizawa, to include the extracting of the electronic address, in order to for a message to be delivered to the right place (Sathaye col. 1, lines 32-35).

Regarding claims 11-12,14, 17, 19, and 21-22 (which depend on claims 8 and 15), Sekizawa discloses the initiating communication includes transmitting an electronic message ordering a predetermined quantity of the consumable determined to be

present in an amount less than the threshold amount (see at least col. 19, lines 15-35; col. 46, lines 7-31); the determining comprises determining using processing circuitry (see at least col. 19, lines 56-57) in response to a sensor in the hard copy output engine sensing that an amount of the consumable is less than the threshold amount (see at least col. 19, lines 22-27; col. 33, lines 31-35; col. 34; col. 34, lines 22-55); the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers (see at least col. 3, lines 11-13; col. 3, lines 44-46); the initiating comprises directly initiating communication with the vendor from the hard copy output engine (see at least col. 19, lines 15-41; col. 20, line 58 – col. 21, line 7); and the processing circuitry is included in the hard copy output engine (see at least col. 19, lines 45-col. 20, line 6; col. 20, lines 51-57; col. 21, lines 9-20; col. 33, lines 36-45; Figure 10).

Regarding claim 15, Sekizawa discloses a computer implemented control system for a hard copy output engine, the system comprising:

- processing circuitry configured (see at least col. 19, lines 45-col. 20, line 6; col. 33, lines 36-45) to:
  - determine that an amount of a consumable for the hard copy output engines is less than a threshold amount (see at least col. 9, lines 44-57; col. 10, lines 3-8; col. 15, lines 22-32; col. 28, lines 44-67; col. 34, lines 23-54); and
  - initiate communication with the supplier using the electronic address (see at least col. 19, lines 15-35).

However, Sekizawa does not explicitly disclose the storing and extracting of an electronic address for a supplier from a non-volatile memory. Sekizawa disclose the ROM (Read Only Memory) memory storing a BIOS program (see at least col. 19, lines 44-47; col. 20, lines 5-16). Sathaye, on the other hand, teaches the storing and extracting of an electronic address for a supplier from a non-volatile memory (see at least col. 1, lines 29-50). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Sekizawa, to include the storing and extracting of the electronic address, in order to keep track of the addresses of addressable network entities (Sathaye col. 1, lines 53-54) and for a message to be delivered to the right place (Sathaye col. 1, lines 32-35).

**Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sekizawa and Sathaye as applied to claim 1 above, and further in view of U.S. Patent No. 6,272,472 to Danneels et al.** Sekizawa and Sathaye substantially disclose the claimed invention, however, it does not disclose the reseller. The combination discloses the manufacturer (see Sekizawa at least col. 19, lines 6-14). Danneels, on the other hand, teaches the reseller (see at least abstract, summary). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Sekizawa and Sathaye, to include the reseller, to provide a convenient way for a purchase to order the product (Danneels col. 3, lines 59-61).

**Claims 2, 5, 9-10, 13, 16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekizawa and Sathaye as applied to claims 1, 8, and 15 above, and further in view of U.S. Patent No. 6,625,581 to Perkowski.**

Regarding claims 2, 9-10, 13, 16, 18, and 20, Sekizawa and Sathaye substantially discloses the claimed invention, however, it does not disclose the extracting of an electronic address which comprises the extracting a universal resource locator. The combination discloses a standard protocol of SMTP and POP3 for transmitting and receiving electronic mail through the Internet (see Sekizawa at least col. 19, lines 15-35). Perkowski, on the other hand, teaches the extracting of an electronic address which comprises the extracting a universal resource locator (see at least col. 45, line 45 – col. 46, line 36). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Sekizawa and Sathaye, to include the universal resource locator, in order to find the web home page of the vendor or supplier (Perkowski col. 46, lines 19-21).

Regarding claim 5, Sekizawa and Sathaye substantially discloses the claimed invention, however, it does not disclose the determining of the electronic address of the supplier is obsolete; determining a revised electronic address for the supplier; and re-programming the non-volatile memory wit the revised electronic address to replace the obsolete electronic address. Perkowski, on the other hand, teaches the determining of the electronic address of the supplier is obsolete; determining a revised electronic address for the supplier; and re-programming the non-volatile memory wit the revised electronic address to replace the obsolete electronic address (see at least col. 46, lines 18-36). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Sekizawa and Sathaye, to include the determining of the electronic address of the supplier is obsolete; determining a revised

electronic address for the supplier; and re-programming the non-volatile memory with the revised electronic address to replace the obsolete electronic address, in order to determine and update whether a particular supplier has a registered address on the Internet (Perkowski col. 46, lines 30-36).

Regarding claims 13 and 18, Sekizawa and Sathaye substantially discloses the claimed invention, however, it does not disclose the servlet. The combination discloses the global Internet (see Sekizawa col. 43, lines 35-38). Perkowski, on the other hand, teaches the servlet (see at least col. 14, lines 5-50; and Figures 2B1, 2B2 and 2B3). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Sekizawa and Sathaye, to include the servlet, in order to provide a Web server environment and can fulfill multiple task (Perkowski col. 48, lines 38-44).

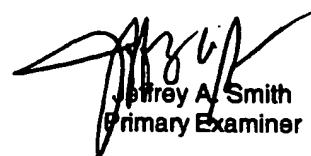
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Mtot  
November 14, 2003



Jeffrey A. Smith  
Primary Examiner

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